

REMARKS

Claims 13-15 are all the claims pending in the application.

Formal Matters

The Examiner has objected to the Abstract alleging that it does not reflect the currently-claimed invention. Applicants has provided a new Abstract of the Disclosure which addresses the Examiner's concerns.

§ 112 Rejection of Claims 13-15

Claims 13-15 have been rejected under the first paragraph of § 112. The Examiner alleges that the specification is not enabling for hard material powders other than cBN or conductive powders other than Co. Applicants respectfully submit that the present specification lists several possibilities for the "hard material" as well as several possibilities for the "conductive material". See, for example, pages 8, 9 and 23 of the original specification. Further, the basic task of mixing two types of powder together is not outside the knowledge of one of skill in the art. Therefore, persons of skill in the art would not need to be provided with specific examples in order to understand how the recited powders are mixed, especially given the specification's detailed description of the intended effect of each powder component. For these reasons Applicants respectfully request that the Examiner withdraw this rejection.

Prior Art Rejections

Claim 13 has been rejected under § 103 as being obvious over the combination of the Applicants' Prior Art ("APA"), taken with either JP 57-061026 or JP 63-200465. The APA

relied upon by the Examiner appears to be the disclosure of JP 5-148615, which is described on page 2 of the specification.

Applicants respectfully submit that the Examiner's § 103 rejection of claim 13 is improper. There is no motivation to combine the APA with either of the '026 or '465 JPs. The '026 reference relates to the coating of a plastic powder with electrically conductive material. The purpose of this process is to produce a plastic molding having a degree of conductivity.

Considering the different materials and the different uses of the final product, the '026 reference represents non-analogous art. There is simply no reason why one of skill in the art of EDM electrode structures would be led to consult the art of plastics molding, as there is simply no relationship or intersection between these two technical areas. Accordingly, Applicants do not believe the '026 reference is relevant to the disclosed and claimed invention.

The '465 reference describes the coating of silver oxide with gold, followed by compression molding the mixture to form a composite electrode for a silver oxide battery. However, and similar to the above, Applicants respectfully submit that the '465 reference is in the battery art and it is, therefore, far removed from the electrode discharge machining art. Further, the teachings of the '026 reference are essentially irrelevant with respect to the teachings of the '465 reference. Therefore, there is no motivation to combine the teachings of the '465 reference with those of the APA or the '026 reference.

Again, considering the materials and the usage of the EDM electrode, there would simply be no reason for one of skill in this art to consult battery technology. The battery electrodes of the '465 reference and EDM electrodes of the present invention are subject to such different

usages and conditions that prior art concerning batteries is simply not relevant to the pending claims.

Similarly, Claim 14 was rejected under § 103 over the combination of the prior art discussed above, taken together with JP 10-130318 and the patent to Onishi. The Examiner argues that the additional references are being applied in order to teach the heat treating of an EDM-type electrode. For the same reasons set out above with respect to claim 13, Applicants submit that there is no motivation to combine the teachings of either the '026 reference or the '465 references with the APA or any of the additional references (the '318 and the Onishi references). As a final matter, it does not appear that the '318 reference is prior art. Specifically, the laid-open date of the '318 JP would appear to be after the priority date to which the present application is entitled.

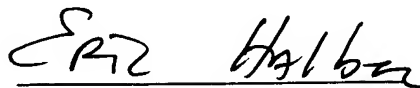
Claim 15 also stands rejected under § 103 over the combination of the prior art discussed above, taken together with JP 10-130318, the patent to Onishi and the patent to Sung. As set out above with respect to claim 14, and for the same reasons set out above with respect to claim 13, Applicants submit that there is no motivation to combine the teachings of either the '026 reference or the '465 references with the APA or any of the additional references (the '318, the Onishi and the Sung references). Again, it does not appear that the '318 reference is prior art because the laid-open date of the '318 JP appears to be after the priority date to which the present application is entitled. For these reasons Applicants respectfully submit that claim 15 remains patentable in view of the cited references.

Lastly, Applicants have amended claims 13 and 14 as set out above to clarify that the electrically conductive coating is used to generate discharge in the surface discharge treatment and that the electrically conductive coating acts as a binder during compression molding. The basis for these amendments is set out in the Specification at page 17, line 15 through page 22, line 7; page 19, lines 15-19; and page 18, lines 18-21. Applicants respectfully submit that neither the '026 reference nor the '465 reference teach, suggest or disclose these limitations, as recited in claims 13 and 14. For this reason, as well as the arguments set forth above with respect to claims 13 and 14, respectively, Applicants respectfully request that the § 103 rejections of claim 13 and 14 be withdrawn.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Eric P. Halber
Registration No. 46,378

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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